

REMARKS

After entry of the present Amendment, claims 1-6 remain in the application, with claim 6 in independent form. Independent claim 1 has been amended to correct an inadvertent grammatical error with regard to the formula for (A¹) by replacing the subscript “a” at the end of the formula with the subscript “d”. Support for this amendment relies on the fact that the formula for (A¹) is similar in structure to the formula for (A³), which properly includes the subscript “d” at the end of the formula. Independent claim 1 has also been amended to delete (A²) from being an available option for the claimed silicone oil (A), and the claimed variables “R⁴” and “p” have likewise been deleted because those variables are only present in the formula for (A²). Claim 7 has been cancelled. No new matter is added through the instant Amendment.

Claim 7 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Claim 7 also stands rejected under 35 U.S.C. §101 as being of improper form for a process claim. Claims 1-5 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,306,957 to Nakano et al. Claim 6 stands rejected under 35 U.S.C. §103(a) over Nakano et al. in view of U.S. PG Publication No. 2004/0254275 to Fukui et al.

Rejection of Claim 7 Under 35 U.S.C. §§101 and 112

The Applicants respectfully submit that these rejections are now moot in view of the cancellation of claim 7 and must, therefore, be withdrawn.

Rejection of Claims 1-5 Relving Upon Nakano et al.

The Applicants respectfully assert that the rejection of claim 1-5 under 35 U.S.C. §102(b) over Nakano et al. are overcome as a result of the amendment of claim 1. As the Examiner is aware, to anticipate a claim under 35 U.S.C. §102, a reference must teach every element of the claim (see MPEP 2131). The Applicants respectfully assert that Nakano et al. fails to anticipate independent claim 1, as amended, on the basis that Nakano et al. fails to teach the silicone oil (A) as it is now claimed in independent claim 1 after entry of the present Amendment.

To summarize the scope of claim 1 with regard to the silicone oil (A), the silicone oil (A) is represented by formula (A¹) and/or formula (A³). Formulas (A¹) and (A³) **always** require that a silicon-bonded hydrocarbon having aliphatic unsaturation is present, and further also require the presence of silicon-bonded OR³. **It is clear that Nakano et al. fails to disclose, teach, or suggest a composition including a silicone oil that has both silicon-bonded hydrocarbons having aliphatic unsaturation and silicon-bonded OR³, in combination with component (B) a heat conductive filler.** As such, Nakano et al. fails to anticipate independent claim 1 of the present application.

Further, there is nothing within the Nakano et al. that provides a basis for a finding of obviousness of independent claim 1 such that independent claim 1 is both novel and nonobvious over Nakano et al.

Rejection of Claim 6 Under 35 U.S.C. §103(a) Over Nakano et al. in View of Fukui et al.

As to this rejection, the Applicants respectfully submit that Fukui et al. is unavailable as a prior art reference to the instant application. In particular, the instant application has an

earliest priority date of November 8, 2002, which has been officially recognized by the USPTO and is reflected on the Filing Receipt that was mailed on January 18, 2006. Fukui et al. was published as US PGPUB 2004/0254275 on December 16, 2004, which is well after the earliest priority date of the instant application. Because Fukui et al. claims priority to foreign patent applications and an international (PCT) application, it is also relevant that none of the foreign or international applications to which Fukui et al. claims priority were published prior to the priority date of the instant application. In particular, the earliest publication date of any foreign or international application in the patent family of Fukui et al. is November 21, 2002, which is the publication date of PCT Application WO02092693A1 to which Fukui et al. claims priority. Because November 21, 2002 is later than the earliest priority date of the instant application, which is November 8, 2002, Fukui et al. does not qualify as prior art to the instant application under either 35 U.S.C. §§102(a) or (b).

As to the availability of PCT Application WO02092693A1 as a prior art reference to the instant application under 35 U.S.C. §102(e), revised 35 U.S.C. 102(e) allows the use of certain international application publications and U.S. patent application publications, and certain U.S. patents as prior art under 35 U.S.C. 102(e) as of their respective U.S. filing dates, including certain international filing dates. The prior art date of a reference under 35 U.S.C. 102(e) may be the international filing date if the international filing date was on or after November 29, 2000, the international application designated the United States, and the international application was published by the World Intellectual Property Organization (WIPO) under the Patent Cooperation Treaty (PCT) Article 21(2) in the English language. See MPEP 2136. While PCT Application WO02092693A1 was filed on or after November 29, 2000, and did designate the

United States, **PCT Application WO02092693A1 was not published in the English language and, therefore, the filing date of PCT Application WO02092693A1 is not available for purposes of 35 U.S.C. §102(e).** Notwithstanding this fact, the Applicants respectfully submit that, even if PCT Application WO02092693A1 were to properly apply as prior art under 35 U.S.C. §102(e), each of the requirements of 35 U.S.C. §103(c) are met such that the instant obviousness rejection of claim 6 that relies upon Fukui et al. is overcome.

In view of the foregoing, it is clear that the Nakano et al. does not disclose or teach (A¹) or (A³) as claimed in independent claim 1 of the present claims. Thus, because Nakano et al. does not anticipate the element of the silicone oil (A) in independent claim 1, and further does not teach a combination of the silicone oil (A) with the heat conductive filler (B) as claimed in independent claim 1 such that claim 1 is novel in view of Nakano et al. Further, there is nothing within Nakano et al. that provides a basis for a finding of obviousness of independent claim 1 over Nakano et al., and Fukui et al. is unavailable as a prior art reference to the instant application such that independent claim 1 is both novel and nonobvious over the prior art relied upon by the Examiner. As such, the Applicants submit that the instant application is in condition for allowance, which allowance is respectfully requested.

The proper fee for a one-month extension of time is included herewith. While the Applicants believe that no further fees are presently due, the Commissioner is authorized to charge the Deposit Account No. 08-2789, in the name of Howard & Howard Attorneys, P.C., for any fees or credit the account for any overpayment.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS

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Date

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